REMARKS

Claims 1-3 and 8-11 remain pending in this application. Claims 1-3 and 8-11 are rejected. Claims 4-7 are withdrawn. Claim 1 is amended herein to place the claim in better form by clarifying an antecedent issue identified by the Examiner. Claim 2 is amended herein as suggested by the Examiner to clarify the language. No change is scope is effected and Applicants respectfully request that the amendment to claims 1 and 2 be entered. The specification and abstract have been amended to place them in better form and/or to correct typographical errors.

Claims 1-3 and 8-11 have been rejected under 35 U.S.C. § 112, second paragraph, as indefinite. The Office Action states that there is no antecedent for "the rubber strip extruded from the die" in the last two lines of claim 1. The Office Action also states that the language of "the temperature as controlled in the die is equal" in claim 2 is confusing and has proposed alternative language. Appropriate amendments have been made in claim 1 to address the antecedent issue and claim 2 has been amended as suggested by the Examiner.

Claims 1-3 and 8-11 have been rejected under 35 U.S.C. § 103(a) as obvious over JP 2002-205512 (JP'512) in view of U.S. Patent No. 5,156,781 (Boehm et al.") and U.S. Patent Publication No. 2002/0089077 (Ogawa et al.) and further in view of U.S. Patent No. 2,746,089 (Hendry) and U.S. Patent No. 2,688,770 (Henning).

To establish a *prima facie* case of obviousness, it is necessary to show that all the claim limitations are taught or suggested by the prior art. *See In re Royka and Martin*, 180 USPQ 580, 583, 490 F.2d 981 (CCPA 1974). Claim 1 recites that the temperature of the casing is higher than that in the screw shaft. There is no indication that the screw in Boehm et al. is to be kept at a lower temperature than the barrel, especially since column 6, lines 6-37 discloses that the screw is heated. Furthermore, Ogawa et al. teaches that the temperature of the screw is higher than the temperature of the cylinder, as explained in paragraph 0039 of Owaga et al., as follows: "It is also preferred that the temperature of the cylinder 11 of the screw unit 2 is maintained to be lower than the temperature of the rubber material flowing near the screw 10, so as to avoid biting of the rubber material and to improve the flow property of the rubber material." Since the temperature of the rubber material near the screw is higher than the temperature of the cylinder, the temperature of the screw is also higher than the temperature of the cylinder. The statement in paragraph 0016 of Owaga et al. that the cylinder is controlled to have a temperature that is lower than the temperature of the rubber material flowing adjacent to a downstream end of the screw is not inconsistent with the teaching in paragraph 0039 of Owaga et al. that the temperature of the screw is higher than the temperature of the barrel and does not limit the disclosure in paragraph 0039 in any way. Additionally, no reasons have been provided for one of ordinary skill in the art to modify any of JP '512 or Boehm et al. or Ogawa et al. to have the

screw be kept at a lower temperature than the barrel. Accordingly, claim 1 is patentable over the cited art.

Additionally, the Office Action provides no reasoning to utilize the die of JP '512 in any of the other cited references, in contravention of Supreme Court precedent. The Supreme Court has made clear that demonstrating that elements are known in the art is insufficient to establish obviousness and explained the importance of identifying a reason to combine the elements in the way the claimed new invention does. *See KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

Also, Boehm et al. discloses in column 2, lines 8-10 that "[w]hen extruding rubber it is desirable to maintain the temperature of the rubber as low as possible, preferably 100°C or less." Thus, there is no reason for one of ordinary skill in the art to modify Boehm et al. to heat the head region to be hotter than the casing, as recited in claim 1, since the objective is to keep the temperature of the rubber low rather than heating the head to be hotter than the casing, which may heat the rubber as well.

The Office Action relies on several references to reject claim 1 but does not state which reference is actually being modified to include all the limitations of claim 1 and does not provide the necessary reasoning to modify any one reference to include all of the limitations of claim 1. Claim 1 includes a number of limitations and the Office Action has not identified how they are all taught or

suggested in the cited art and combined into one reference. Moreover, the first reference cited by the Office Action is JP '512, and the Office Action states on page 3 regarding JP '512 that "[d]etails of the extruder beyond the implied die shape are not however provided." The Office Action then fails to provide any reasoning for modifying JP '512 to include all the limitations of claim 1. Accordingly, a proper *prima facie* case of obviousness has not been made and claim 1 is therefore patentable over the cited art for this reason as well. Claims 2-3 and 8-11 are patentable at least for the reason that they depend from a patentable base claim. *See In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

Applicants submit herewith a substitute specification and abstract wherein amendments are effected to place the text thereof into proper form and to correct typographical errors. Also accompanying this amendment is a reproduction of the original specification and abstract with markings indicating the amendments effected in the substitute specification and abstract.

Applicants respectfully request a one month extension of time for responding to the Office Action. **The fee of $120.00 for the extension is provided for in the charge authorization presented in the PTO Form 2038, Credit Card Payment form, provided herewith.**

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In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
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